

REMARKS

I. Introduction

Claims 1-6, 8, 10-14, 16-21 are currently pending in this application. Claims 7, 9, and 15 have been canceled. Claims 1, 8, 13, 14, and 16 have been amended. Claims 18-21 have been added. Amendments to the claims find support in the specification as originally filed at, for example, paragraphs 9 and 10. New claims find support in the specification as originally filed at, for example, paragraphs 62-63.

The Examiner has rejected claims 1-6, 8, 10-14, 16, and 17 under 35 U.S.C. § 101 as failing to be directed to patentable subject matter.

II. § 101 Rejections

Applicant respectfully submits that the Examiner has not made a proper analysis of the claims and set forth facts sufficient to prove that the claims are not directed to patentable subject matter under 35 U.S.C. § 101. In the non-final office action of August 4, 2010, the Examiner acknowledges that the machine-or-transformation test is not the sole test for patent eligibility, but asserts that it may be used as an investigative tool. The Examiner then concludes that “an analysis of the instant specification concludes that the claimed invention fails the MOT test.” To support this conclusion, the Examiner replicates bits and pieces of the specification. In doing so, the Examiner has not used the machine-or-transformation test as an investigative tool to determine if the claimed invention falls within one of the three specific exceptions to patent eligible subject matter identified by the Supreme Court in *Bilski*; laws of nature, physical phenomena, and abstract ideas. *Bilski v. Kappos*, 130 S.Ct. 3218, 3225 (2010). The Examiner has merely reapplied the machine-or-transformation test to parts of the specification. A rejection

based on such an analysis is improper.

A § 101 patentability analysis must be directed to the claims as a whole, not individual limitations. *See Parker v. Flook*, 437 U.S. 584, 590 (1978) (holding that a process is not unpatentable simply because it contains a law of nature or a mathematical algorithm). In *Bilski*, the Court recognized “the need to consider the invention as a whole, rather than ‘dissect[ing] the claims into old and new elements and then . . . ignor[ing] the presence of the old elements in the analysis.’” *Bilski*, 130 S.Ct. at 3230 (quoting *Diamond v. Dieher*, 450 U.S. at 188). Accordingly, a proper rejection must take into account all the elements of the claims, both independent and dependent, and must set forth facts sufficient to show that the claims are directed to either: a law of nature; physical phenomena; or an abstract idea. Applicant respectfully submits that under a proper analysis the claims are not abstract and are tied to a specific machine.

A. Claims 1-6

In order to advance the prosecution of this application independent claim 1 has been amended to include the steps of entering industry standard values and a plurality of change in wealth factors and their timeframes into a calculating program, and utilizing the calculating program to assign numerical values to change in wealth factors, adjust these numerical values, tally industry standard values and the assigned numerical values and assign a value position to the data. This information is then used to frame a response and submit the framed response to a buying organization. Applicant respectfully submits that these claims are patentable subject matter under *Bilski* are not an abstract idea and meet the machine-or-transformation test.

Claim 1 is directed to a tangible method of calculating a value position and using

the calculated value position to frame a response to a buying organization to win a complex contract competition. As a method, the subject matter qualifies for patent-eligibility as a process under 35 U.S.C. § 101 as defined by the “process” definition in 35 U.S.C. § 100. Since *Bilski*, the Federal Circuit has recognized an abstract idea as one that “exhibit[s] itself so manifestly as to override the broad statutory categories of eligible subject matter and the statutory context that directs primary attention on the patentability criteria of the rest of the Patent Act.” *Research Corp. Tech. v. Microsoft*, 2010 WL 4971008, at 7 (Fed. Cir. 2010). This is not the case here, and the Examiner has not set forth facts sufficient to meet the initial burden of such a conclusion.

Because claim 1 is not directed to a mere algorithm, the use of a well established principle, or an overreaching idea, it is not abstract. Claim 1 takes tangible steps to modify data, produce a tangible result, and then use that result to frame and submit a response to a buying organization. In cases such as this, where the claimed invention presents functional and palpable application in its field of technology, the courts have found that the claimed invention is not an abstract idea. *See Id.* at 7. Just because several steps of the process utilize a mathematical equation does not mean that the claimed invention is automatically an abstract idea. *See Id.*; *Diehr*, 450 U.S. at 185; *Bilski*, 130 S.Ct. at 3230. As discussed above, the claim as a whole must be taken into consideration. While certain mathematical operations are used, the specification instructs one how to compare the results to an industry norm, order the results, and use this information to frame a response to a request.

Furthermore, the invention of claim 1 is not abstract in that those of ordinary skill in the art would reach the same results when using the variables in practicing the claimed

method. Upon viewing the specification, one of ordinary skill in the art would be familiar with statistical modeling techniques that would be used to separate complex influences of multiple wealth factors that may be chosen from various data sources. As instructed by the specification, a value position is then determined by comparing the factors to an industry standard, and a response is framed accordingly. When practicing the claimed method, users will reach the same results for value positions based on known industry standards. Because a tangible, repeatable result is produced by practicing the method of claim 1, the claimed invention cannot be considered an abstract idea.

Apart from not being an abstract idea, claim 1 is also tied to a machine. As currently amended, the claim recites a computerized method which is implemented by a calculating program. The calculating program receives input data and produces a result to be used in framing a response. These elements tie the claim to a computing device capable of executing a program, for example a PC. Thus an integral part of the method is tied to a machine, not mere post-solution activity.

In light of the above, Applicant respectfully requests the withdrawal of the rejection to claim 1. Because claims 2-6 are dependent from claim 1, and for the additional limitations set forth therein, Applicant respectfully requests the withdrawal of the rejection from these claims as well.

B. Claims 8, 10-12

Applicant submits that independent claim 8 is not an abstract idea for the same reasons set forth above in section II.A. Moreover, claim 8, as currently amended, is tied to a machine. Claim 8 recites entering information into a computer program which performs a variety of steps and issues an output. Similar to claim 1 as discussed above,

these elements tie the claim to a computing device capable of executing a program, for example a PC. Thus an integral part of the method is tied to a machine, not mere post-solution activity.

In light of the above, Applicant respectfully requests the withdrawal of the rejection to claim 8. Because claims 10-12 are dependent from claim 8, and for the additional limitations set forth therein, Applicant respectfully requests the withdrawal of the rejection from these claims as well.

C. Claims 13 and 14

Applicant submits that independent claims 13 and 14 are not an abstract idea for the same reasons set forth above in section II.A. Moreover, claims 13 and 14 are tied to a machine. Claims 13 and 14 are system claims which recite a computer having a display and a computer program executable by the computer capable of receiving an input, performing a number of functions, and displaying an output. Accordingly, every element in these claims is tied to a computer system. Thus an integral part of the claims are tied to a machine, not mere post-solution activity.

In light of the above, Applicant respectfully requests the withdrawal of the rejections to claims 13 and 14.

D. Claims 16 and 17

Applicant submits that independent claim 16 is not an abstract idea for the same reasons set forth above in section II.A. Moreover, claim 16 is tied to a machine. Claim 16 is directed to a computer readable medium having an encoded computer-executable program. Accordingly, every element in these claims is tied to a computer system. Thus an integral part of the claims are tied to a machine, not mere post-solution

activity.

In light of the above, Applicant respectfully requests the withdrawal of the rejection to claim 16. Because claim 17 is dependent from claim 16, and for the additional limitations set forth therein, Applicant respectfully requests the withdrawal of the rejection from this claim as well.

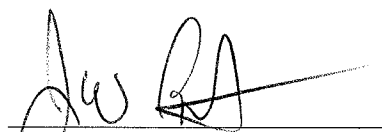
III. Conclusion

It is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, there being no other objections or rejections, this application is in condition for allowance, and a notice to this effect is earnestly solicited.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided below.

If any further fees are required in connection with the filing of this amendment, please charge the same to Deposit Account 50-0548. Also, please accept this paper as a petition for extension if one is deemed necessary.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'JW Berenato', written over a horizontal line.

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